



MAY 23 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

SUGHRUE, MION, ZINN
MACPEAK & SEAS
2100 Pennsylvania Avenue, NW
Washington, DC 20037 3213

| | | |
|-------------------------------------|---|----------------|
| In re Application of | : | DECISION ON |
| PRELAS et al. | : | |
| Application No.: 09/600,279 | : | PETITION UNDER |
| PCT No.: PCT/US99/00380 | : | |
| Int. Filing Date: 15 January 1999 | : | 37 CFR 1.47(a) |
| Priority Date: 16 January 1998 | : | |
| Attorney Docket No.: Q43649 | : | |
| For: SOLID STATE ELECTRIC GENERATOR | : | |
| USING RADIONUCLIDE-INDUCED EXCITON | : | |
| PRODUCTION | : | |

This is a decision on applicants' "SUBMISSION UNDER § 37 CFR 1.425(a) OF DECLARATIONS ON BEHALF OF JOINT INVENTORS WHO CANNOT BE FOUND OR REFUSE TO JOIN IN AN INTERNATIONAL APPLICATION" filed in the United States Patent and Trademark Office (USPTO) on 05 February 2001, which has been treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 15 January 1999, applicants filed international application PCT/US99/00380, which claimed a priority date of 16 January 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 22 July 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 August 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 July 2000 (16 July 2000 being a Sunday).

On 14 July 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 04 August 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a one-month extendable period for reply.

On 05 February 2001, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*: a petition for a five-month extension of time; the fee for a five-month extension of time; the surcharge under 37 CFR 1.492(e); a series of declarations executed by four of the five joint inventors; a copy of several e-mails; and a copy of a letter sent to the non-signing joint inventor.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to (1), the fee of \$130.00 under 37 CFR 1.17(h) has been charged to Deposit Account 19-4880, as authorized in the petition under 1.47(a) filed 05 February 2001.

As to (3), a statement of the last known address of Mr. Dann has been provided.

As to (2), the petition does not include sufficient proof to establish that inventor Dann could not be found or reached after diligent effort. The petition is accompanied by a letter represented by counsel to have been sent to Mr. Dann at his last known address, along with the declaration. However, it is unclear whether this letter was delivered or returned. No documentary evidence showing the return of the letter has been made of record. (Note that it is not clear whether any type of means to verify receipt was used.) This letter is dated 02 February 2001 and the petition was filed 05 February 2001. It is not clear whether delivery of this letter was even attempted before the filing of the petition. Moreover, even assuming *arguendo* that delivery was attempted and was even successful, the time frame for reply in this instance was not a reasonable time frame.

The petition states that "Mr. JENNINGS has been the focal point for having the declarations executed by Messrs. MOUNTFORD and DANN." In this regard, note MPEP 409.03(d), which provides:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions. (Emphasis added).

Finally, it is noted that applicants failed to show or provide proof that a copy of the application papers (specification, including claims, drawings, and oath or declaration) were

presented to the non-signing inventor. The copy of the letter mailed by petitioner to Mr. Dann states that only a declaration was sent to the non-signing inventor.

As to (4), each executed declaration must identify each inventor. The declaration executed Mark A. Prelas only identifies Mr. Prelas as an inventor and fails to identify the other four joint inventors. Additionally, (i) the declaration signed by Mr. Mountford lists Andrew W. Mountford as the inventor while the PCT application and the declarations signed by the other joint inventors list Andrew Mountford (without a middle initial) as the inventor and (ii) the declaration signed by Mr. Jennings lists Howard T. Jennings as the inventor while the PCT application and the declarations signed by the other joint inventors list Howard J. Jennings as the inventor. Attention is directed to MPEP § 605.04(c) if there has been a change of name and to MPEP § 605.04(g) if there is a typographical error. Finally, it is noted that each executed declaration should properly identify each inventor. Consequently, a new oath or declaration properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, may be required.

In sum, items (1) and (3) have been met. Items (2) and (4) have not been met.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459